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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,694	11/09/2001	Takahiro Ishioroshi	Q67018	5831

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EXAMINER

CULLER, JILL E

ART UNIT PAPER NUMBER

2854

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/986,694

Applicant(s)

ISHIOROSHI ET AL.

Examiner

Jill E. Culler

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. Claims 5-9, 13-15 and 20-25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims are drawn toward the operation of the system, rather than toward the structure of the system.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 6-11, 13-16 and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,303,336 to Kageyama et al.

With respect to claim 1, Kageyama et al. teaches a system for designating process information comprising a process execution apparatus, 17, for executing a given process, a process control apparatus, 16, which executes a prescribed process control of the process execution apparatus, and a process designating apparatus, 15, which designates the process control of the process control apparatus, see column 4, lines 52-53, where the process designating apparatus possesses a designation

information list, 152, for the process control, see column 4, lines 53-61, and the process control apparatus possesses a control mode table, part of 163, including a control mode which defines the actuation of the process designating apparatus, an information reader, 161, which reads the designation information from the designation information list, and a process controller, 168, which acquires a prescribed control mode from the control mode table to perform the process control of the process execution apparatus. See column 4, line 65 - column 5, line 12.

With respect to claim 2, Kageyama et al. teaches that the process designating apparatus makes a process designation via a local area network or through a communication apparatus, 10, 153, see column 4, lines 38-45 and lines 61-64.

With respect to claim 3, Kageyama et al. teaches an information registration apparatus, 111, 121, 131, for intensively performing the registration of the designation information in the process designation apparatus and the registration of the control mode in the process control apparatus at one portion. See column 4, lines 46-49.

With respect to claim 10, Kageyama et al. teaches a method for designating process control in a system for designation process information comprising a process execution apparatus, 17, for executing a given process, a process control apparatus, 16, which executes a prescribed process control of the process execution apparatus, and a process designating apparatus, 15, which designates the process control of the process control apparatus, see column 4, lines 52-53, where the process designating apparatus possesses a designation information list, 152, for the process control, see column 4, lines 53-61, and the process control apparatus possesses a control mode

table, part of 163, including a control mode which defines the actuation of the process designating apparatus, an information reader, 161, which reads the designation information from the designation information list, and a process controller, 168, which acquires a prescribed control mode from the control mode table to perform the process control of the process execution apparatus, see column 4, line 65 - column 5, line 12, the method comprising a steps in which the control apparatus performs a prescribed process control at the presently acquired process control mode until the process execution apparatus completes the process, a step in which after the process execution has been completed, the process control apparatus makes a query for the designation information to the process designating apparatus, a step in which, upon receiving the query for the designation information, the process designating apparatus reads the designation information from the designation information list and presents the information utilizing a response signal to the process control apparatus, a step in which the process control apparatus judges whether or not the control mode is switched to the next mode, and a step in which, if the process control apparatus is judged to switch the control mode into the next control mode, the process control apparatus acquires a prescribed control mode from the control mode table and initiates the acquired control. See column 5, lines 7-32.

With respect to claims 11 and 16, Kageyama et al. teaches that the designation information list comprises specification information of a product, see column 4, lines 55-61, and that the control mode table defines printing data which is registered for a plurality of products. See column 5, lines 4-7. In both claims, the phrase "to be

packaged" is a recitation of what is desired to happen in the future, but does not positively recite a method step, and therefore is given no patentable weight in the claim.

Claims 6-9, 13-15 and 20-25 are rejected along with claims 1 and 3 because no further structure of the system has been recited.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-5, 17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama et al. in view of U.S. Patent No. 5,580,177 to Gase et al.

With respect to claim 4, Kageyama et al. teaches all that is claimed, as in the above rejection of claims 1-3, 6-11, 13-16 and 21-25, except that the process designating apparatus has a monitor for monitoring the operating condition of the process execution apparatus.

Gase et al. teaches a system having a process designating apparatus, 16, with a monitor, 24, for monitoring the operating condition of a process execution apparatus, 20. See column 5, lines 9-12.

It would have been obvious to one having ordinary skill in the art at the time of the invention to use the monitor of Gase et al. with the system of Kageyama et al. in

order to more efficiently schedule process execution activities based on the status of the process execution apparatus.

Claim 5 is rejected along with claim 4 because no further structure of the system has been recited.

With respect to claim 17, Kageyama et al. teaches that the designation information list comprises an operating condition, which comprises a producing condition wherein a process execution apparatus executes printing, a switching condition wherein a process execution apparatus has completed printing and is ready to switch to a different control mode, and a stopping condition wherein the process execution apparatus is done printing and is ready to switch to a different control mode. See column 8, lines 3-10 and column 9, lines 54-62.

Kageyama et al. does not teach a plurality of process execution apparatuses.

Gase et al. teaches a system having a plurality of process execution apparatuses, 18, 20, 22, and necessary operation information in a designation information list, 34. See column 3, lines 4-7 and lines 55-58.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system of Kageyama et al. using a plurality of process execution apparatuses, as taught by Gase et al., to be able to complete the execution of processes more efficiently.

With respect to claim 19, Kageyama et al. teaches all that is claimed, as in the above rejection of claims 1-3, 6-11, 13-16 and 21-25, except that the information reader comprises a timer, wherein the information reader reads the designation information

from the process designation apparatus and automatically makes a query for the designation information of the designation information list of a product at a predetermined given timing according to the timer.

Gase et al. teaches an information reader, 24, 30, which comprises a timer and automatically collects information at a predetermined timing according to the timer. See column 4, lines 39-40 and column 5, lines 9-11.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system of Kageyama et al. using a timer, as taught by Gase et al., to automatically update the designation information on a regular basis.

Claim 20 is rejected along with claim 19 because no further structure of the system has been recited.

6. Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kageyama et al. in view of U.S. Patent No. 6,067,103 to Ewert et al.

Kageyama et al. teaches all that is claimed, as in the above rejection of claims 1-3, 6-11, 13-16 and 21-25, except that the designation information list comprises: a product number which comprises information directed to a number for distinguishing a kind of product to be dealt with by the designating process information system, a lot number which comprises information to identify a date and place of production and to identify parts making up the product, a number of products which comprises information prescribing the number of products to be printed in a given lot and a destination which comprises information of a receiver, a receiver's address and an orderer.



Ewert et al. teaches a system for designating process information with a designation information list that comprises a product number, comprising information directed to a number for distinguishing a product, a lot number, comprising information to identify a product, and a destination, comprising shipping information. See column 3, lines 39-44.

It would have been obvious to one having ordinary skill in the art at the time of the invention to form the designation information list of Kageyama et al. including the information taught by Ewert et al. in order to more effectively identify the items being acted on by the process execution apparatus. Although Ewert et al. does not explicitly teach that the designation information list also includes a number of products to be printed in a given lot, it would be obvious to one having ordinary skill in the art that this information would be included in order to better control the execution of the process execution apparatus.

### ***Response to Arguments***

7. Applicant's arguments filed February 6, 2004 have been fully considered but they are not persuasive.

With regard to applicant's arguments with respect to the objection to claims 6-9 and 13-15, although applicant is correct in stating that functional language does not render a claim improper, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). The recitation of these claims does not

provide further structure for the apparatus, and therefore the objection to the claims is proper. See MPEP 2114 for further discussion.

With regard to applicant's arguments that Kageyama does not teach the elements of the present invention, the examiner would like to point out that, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). (See MPEP 2111) In this case, although the terms used in the prior art reference do not match those of the claimed invention, given their broadest reasonable interpretation, the terms of the claimed invention apply to the structure of the prior art reference as well. Also, applicant is referred to the above discussion of functional claim language. If the language of the claim does not provide further structure for the apparatus, it is not given patentable weight and therefore cannot distinguish between the claimed application and the prior art.

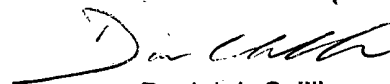
### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill E. Culler whose telephone number is (571) 272-2159. The examiner can normally be reached on M-Th 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jec



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